REMARKS

Claims 1-12 are pending, with claims 1, 4, 7 and 8 being independent.

Claims 1-12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over **JP 3-44624** in view of Ohganawa et al. (U.S. Patent No. 5,617,230) ("**Ohganawa**").

JP 3-44624 is alleged to disclose a display device 16 comprising a pointer including an indicating part 17; pointer driving means for rotating the pointer (not shown); a display element 11 including a fixed display part 14 (or index part) indicated by the indicating part and consisting of a pair of translucent substrates; and a light shielding part 15 formed on top of the top translucent substrate of the display element, wherein the fixed display part made of an opening 14 of the light shielding part; a variable display part 12 made of a region where the light shielding part is not provided; a light emitting element 18 for illuminating the display element from behind is provided; and the light shielding part is provided around the opening.

The Examiner alleges that **JP 3-44624** "discloses a display that is basically the same as that recited in claims 1-12", but acknowledges that **JP 3-44624** does not teach stripe-shaped transparent electrode films respectively formed on the translucent substrates and the light shielding part provided around the opening with a predetermined width.

Ohgawara (Fig. 3) is alleged to disclose a dot matrix type LCD element comprising stripe-shaped transparent electrode films respectively formed on translucent substrates (col. 3, lines 36-50), wherein a light shielding part 26 having a predetermined width is formed around an opening 21 (display region) to perform visual representation while maintaining sufficient uniformity and hence to provide high display quality (col. 17, lines 59-67).

The Examiner alleges it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the display of **JP 3-44624** with the teaching of **Ohgawara** "by forming a dot matrix type liquid crystal display element comprising stripe-shaped transparent electrode films respectively formed on translucent substrates and the light shielding part provided around the opening with a predetermined width so as to obtain sufficient uniformity and to display various figures and characters with high display quality".

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art". *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970); *see also In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995)(*stating* "[w]hen evaluating the scope of a claim, every limitation in the claim must be considered").

It is respectfully submitted that, with regard to at least the subject matter recited in original claim 3, which is now incorporated into claims 1 and 4 (and claims depending therefrom), the Examiner has not shown that **Ohgawara** teaches or suggests, alone or in combination with **JP 3-44624**, a fixed display part "made of an opening of the light shielding part, wherein said light shielding part is provided around the opening to have a predetermined width larger than a diagonal length of a pixel, and wherein said predetermined width corresponds to an offset between the inner periphery of the opening of the light shielding part and an outer periphery of the fixed display part." The Examiner has merely inferred that, in **Ohgawara**, "[s]ince the opening consists of a plurality of dots or pixels (col. 6, lines 46-57), the predetermined width is larger than a diagonal of a pixel." However, the Examiner refers to the overall size of the opening (e.g., 21) and not the offset between

the inner periphery of the opening of the light shielding part and an outer periphery of the fixed display part, as claimed. **Ohgawara** neither shows nor suggests such offset.

In fact, **Ohgawara** *teaches away from* such offset, noting *throughout* the specification that the that the peripheries of the color filters 13 (i.e., the display region) overlap the light shielding layers (see, e.g., col. 8, lines 35-42, stating with regard to Fig. 3, "the peripheries of the color filters 21 overlap the light shielding layers). Such evidence of teaching away constitutes evidence of non-obviousness. See, e.g., *In re Bell*, 991 F.2d 781, 26 USPQ2d 1529 (Fed. Cir. 1993); *Specialty Composites v. Cabot Corp.*, 845 F.2d 981, 6 USPQ2d 1601 (Fed. Cir. 1988); *In re Hedges*, 783 F.2d 1038, 228 USPQ 685 (Fed. Cir. 1986); *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983); *In re Marshall*, 578 F.2d 301, 198 USPQ 344 (CCPA 1978).

Accordingly, it is submitted that the applied combination of **Ohgawara** and **JP 3-44624** is factually and legally insufficient to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a) and reconsideration and withdrawal of this rejection is requested as to claims 1 and 4-6 for at least the above reasons.

Claims 7 and 8 each provide a display device comprising a first display plate including a fixed display part and a second display plate made of a dot matrix type display element and disposed in front of or behind the first display plate. The Examiner alleges a combination of **Ohgawara's** dot matrix type liquid crystal display element with **JP 3-44624** would have been obvious "to display various figures and characters with high quality display" (see pages 3-4 of Paper No. 6).

JP 3-44624 provides a display plate including a fixed display part and **Ohgawara** provides a liquid crystal display. In fact, Applicants' description of the Background Art notes LCD display

elements (see Fig. 13). However, neither **Ohgawara** nor **JP 3-44624**, nor the disclosed prior art, suggest the claimed combination of a dot matrix type display element with a fixed display part. Instead, **Ohgawara** and **JP 3-44624** apply these technologies separately and in isolation. The fact that this combination may appear simple in hindsight is an improper standard under which to assess obviousness and, in turn, patentability. "Simplicity is not inimical to patentability" *In re Oetiker*, 24 USPQ2d 1443, 1446 (Fed. Cir. 1992).

Moreover, in determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention *as a whole* would have been obvious. See, e.g., *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 231 USPQ 81, 93 (Fed. Cir. 1986); *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530 (Fed. Cir. 1983). The motivation to support the ultimate legal conclusion of obviousness under 35 U.S.C. §103 is not an abstract concept, but must stem from the applied prior art as a whole and must have *realistically* impelled one having ordinary skill in the art to modify a specific reference in a specific manner to arrive at a specifically-claimed invention. *In re Newell*, 891 F.2d 899, 13 USPQ2d 1248 (Fed. Cir. 1989).

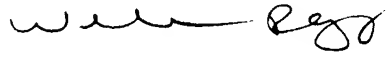
Accordingly, it is submitted that the combination of **Ohgawara** and **JP 3-44624** do not themselves, *as a whole*, suggest the invention of claims 7 or 8 or of claims dependent thereon and are legally insufficient to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a). Reconsideration and withdrawal of this rejection is requested as to claims 7-12 for at least the above reasons.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including

extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT, WILL & EMERY



William D. Pegg
Registration No. 42,988

600 13th Street, N.W.
Washington, DC 20005-3096
(202) 756-8000 WDP/SAB:kap
Facsimile: (202) 756-8087
Date: September 9, 2003